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Remarks

Claims 1 – 5 are pending in the application. Claims 1 – 10 were rejected by the Examiner. Claims 6 – 10 were cancelled by the Applicants. The Applicants reserve the right to reintroduce subject matter from these cancelled claims at a later stage of prosecution, including in later related applications such as continuations, continuations-in-part, or divisions. The Applicants respectfully traverse these rejections and request the Examiner to give due consideration to the arguments presented herein.

Title of the Application

The Examiner is requiring that the Applicants change the title because the current title is not descriptive. In response to this requirement, the Applicants hereby request that the Examiner enter a change in the title from "DISPLAY DEVICE" to "DISPLAY DEVICE WITH OPTICAL WAVEGUIDE." The Applicants respectfully submit that this changed title is sufficiently descriptive.

Arguments**I. Rejections Pursuant to 35 U.S.C. § 102(b)****Claims 1 and 3 – 5**

Claims 1 and 3 – 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Abstract JP 2000-347041 (the "Tanaka Abstract"). The Applicants respectfully submit that the Tanaka Abstract fails to disclose every limitation and therefore cannot anticipate the claims. For a prior art reference to anticipate, 35 U.S.C. § 102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The Tanaka Abstract fails to meet this standard.

Among other things, claim 1 (and claims 2 – 5, all of which depend directly or indirectly from claim 1) recites "an image display panel having a first substrate which is provided with electrodes at a pixel area. . . ." As pointed out by the examiner, the Tanaka

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Abstract discloses a liquid crystal display section numbered 4 in the drawing. However, the abstract cited does not disclose that a pixel area is present in the apparatus disclosed and briefly described in that abstract. Additionally, the Tanaka Abstract fails to disclose electrodes as claimed by the Applicants. For at least these reasons, the anticipation rejections should be withdrawn.

II. Rejections Pursuant to 35 U.S.C. § 103(a)

Claim 2

Claim 2 stands rejected pursuant to 35 U.S.C. § 103(a) as unpatentable over the Tanaka Abstract. No secondary reference is provided. The Applicants respectfully traverse this rejection and submit that the Examiner has failed to establish a prima facie case of unpatentability as required for Section 103(a) rejections. Specifically, the Applicants submit that the Examiner's assertion that claimed limitations, namely that both the claimed optically transparent material and the claimed optically transparent layers are substantially optically anisotropic is "common and known in the art" is insufficient to establish a prima facie case. Additionally, the Examiner's assertion, even if correct, fails to cure the deficiencies previously mentioned with respect to the Tanaka Abstract.

An applicant for a patent is entitled to have a patent grant from an application if, in the absence of other bases for rejecting the application, an Examiner cannot produce a prima facie case of unpatentability. In re Octiker, 977 F.2d 1443, 1444 (Fed. Cir. 1992). When more than one reference is required to establish a proper obviousness rejection, "[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992) (citing In re Fine, 837 F.2d 1071, 1074). The Examiner must show why it would appear that the references would have been combined. In re Fine, 837 F.2d at 1074.

The mere existence of claimed elements in the prior art is insufficient to support an obviousness rejection. "Virtually all inventions are necessarily combinations of old elements." Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1566 (Fed. Cir.

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1983). "It is well established in patent law that a claim may consist of all old elements . . . for it may be that the combination of the old elements is novel and patentable. Similarly, it is well established that a claim may consist of all old elements and one new element, thereby being patentable." Clearstream Wastewater Sys., Inc. v. Hydro-Action, Inc., 206 F.3d 1185 (Fed. Cir. 2000).

Obviousness determinations under Section 103 require that the claimed invention be evaluated as a whole. As explained by the Federal Circuit,

[w]ithout this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. Section 103 precludes this hindsight discounting of the value of new combinations by requiring an assessment of the invention as a whole.

Panduit Corp. v. Dennison Mfg. Co., 1 USPQ2d 1593, 1595-96 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987).

It is inappropriate for an Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. MPEP § 2144.03. Specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. Id. (citing In re Ahlert, 424 F.2d at 1091). It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Id. For at least these reasons, this rejection should be withdrawn.

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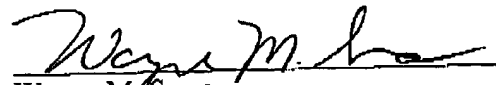
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Conclusion

For at least the foregoing reasons, the Applicant respectfully requests that the Examiner reconsider and withdraw the current rejections and allow the claims to issue. In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1884.

Respectfully submitted,

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